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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,795	06/06/2001	Sancho Enrique David		5531

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EXAMINER

WINTER, JOHN M

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,795

Applicant(s)

DAVID, SANCHO ENRIQUE

Examiner

John M Winter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-20 and 26-30 is/are allowed.
- 6) ☒ Claim(s) 1-15 and 21-23 is/are rejected.
- 7) ☒ Claim(s) 24, 25 and 31-32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/6/2002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Status

Claims 1-32 have been examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 –15 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman et al., (US Patent Application Publication US 2002/0174067)

As per claim 1

Hoffman et al.,('067) discloses a system for permitting a secure electronic transaction on a network, said network comprising

a user device having a fingerprint, (Figure 1)

a provider's server and further comprising a means for providing verification of user's identity,.(Paragraph 23)

The term “ whereby in response to a request by said provider's server said means for providing verification positively identifies the fingerprint of the user device, requests a confirmation from said user device of said transaction and upon receiving said confirmation completes the transaction” is a non-functional descriptive item. The term “ whereby in response to a request by said provider's server said means for providing verification positively identifies the fingerprint of the user device, requests a confirmation from said user device of said transaction and upon receiving said confirmation completes the transaction” could be replaced with other terms. i.e. “means for transferring data” , etc and not change the limitations of the claim. PTO’s guidelines for examining claimed language require: the examiner must make a determination, whether the claimed invention “as a whole” would have been obvious at the time of invention to one of ordinary skill in the art. See MPEP 2142. In the pending claim, the examiner submits that particular language does not serve as a limitation on the claim. In other **words language that is not functionally interrelated with useful acts, structure, or properties of the claimed invention will not serve as a limitation.** See *in re Gulak*, 217 USPQ 401 (CAFC 1983), *ex parte Carver*, 227 USPQ 465 (BdPatApp& Int 1985) and *in re Lowry*, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims

As per claim 2,

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Hoffman et al.,('067) discloses the system according to claim 1 wherein the network is a public network.(Figure 1)

As per claim 3,
Hoffman et al.,('067) discloses the system according to claim 2 wherein the user device is a computer.(Figure 1)

As per claim 4,
Hoffman et al.,('067) discloses the system according to claim 2 wherein the user device is a cell phone. (Paragraph 76)

As per claim 5,
Hoffman et al.,('067) discloses the system according to claim 2 wherein the user device is a television (Paragraph 76)

As per claim 6,
Hoffman et al.,('067) discloses the system according to claim 2 wherein the user device is a means for accessing the Internet. (Paragraph 164; Figure 1)

As per claim 7,
Hoffman et al.,('067) discloses the system according to claim 2 further comprising one or more tool box servers which identifies the fingerprint of the user device.(Figure 12)

Claims 8- are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman et al., (US Patent Application Publication US 2002/0174067)

As per claim 8,
Hoffman et al.,('067) discloses the system for permitting a secure electronic purchase transaction on a public computer network, said network comprising
a user's computer, a vendor's server, and further comprising a means for providing verification of user's identity,(Figure 1)

The term "in response to a request by said vendor's server said means for providing verification positively identifies user's computer, requests a confirmation from said user's computer of said transaction and upon receiving said confirmation provides vendor's server with a means for receiving payment" is a non-functional descriptive item. The term "in response to a request by said vendor's server said means for providing verification positively identifies user's computer, requests a confirmation from said user's computer of said transaction and upon receiving said confirmation provides vendor's server with a means for receiving payment" could be replaced with other terms. i.e. "means for transferring data", etc and not change the limitations of the claim. PTO's guidelines for examining claimed language require: the examiner must make a determination, whether the claimed invention "as a whole" would have been obvious at the time of invention to one of ordinary skill in the art. See MPEP 2142. In the pending claim, the examiner submits that particular language does not serve as a limitation on

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the claim. In other words language that is not functionally interrelated with useful acts, structure, or properties of the claimed invention will not serve as a limitation. See in re Gulak, 217 USPQ 401 (CAFC 1983), *ex parte Carver*, 227 USPQ 465 (BdPatApp& Int 1985) and in re Lowry, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims

As per claim 9,
Hoffman et al.,('067) discloses the system according to claim 8 further comprising a creditor's server which receives a request from a vendor's server for a commitment to pay and issues vendor's server a commitment for payment.(Abstract, Figure 1)

As per claim 10,
Hoffman et al.,('067) discloses a system in accordance with claim 9, wherein said means for providing verification is a toolbox server that positively identifies user's computer by first accessing said user's computer via a gatekeeper.(Figure 1)

As per claim 11,
Hoffman et al.,('067) discloses a system in accordance with claim 10, wherein said wherein said toolbox server transmits to said gatekeeper a pair of identification numbers, wherein the first of said identification numbers is for gaining admittance and the second of said identification numbers is for priming said gatekeeper for admittance on a subsequent occasion.(Figure 1)

As per claim 12,
Hoffman et al.,('067) discloses a system in accordance with claim 11, wherein said wherein said tool box server and said vendor server are the same.(Figure 1)

As per claim 13,
Hoffman et al.,('067) discloses a system in accordance with claim 11, wherein said wherein said creditor server and said tool box server are the same.(Figure 1)

As per claim 14,
Hoffman et al.,('067) discloses in a computer network, a system for performing a secured transaction between a user's computer, and a vendor's server
wherein said user's computer has received fingerprint programming from said vendor's server.(Figure 1)

The term "for creating a digital fingerprint for use by said vendor's server to identify said user's computer" is a non-functional descriptive item. The term "for creating a digital fingerprint for use by said vendor's server to identify said user's computer" could be replaced with other terms. i.e. "a digital ID to identify said user's computer or a hardware identifier", etc and not change the limitations of the claim. PTO's guidelines for examining claimed language require: the examiner must make a determination, whether the claimed invention "as a whole" would have been obvious at the time of invention to one of ordinary skill in the art. See MPEP 2142. In the pending claim, the examiner submits that particular language does not serve as a limitation on

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the claim. In other words language that is not functionally interrelated with useful acts, structure, or properties of the claimed invention will not serve as a limitation. See in re Gulak, 217 USPQ 401 (CAFC 1983), *ex parte Carver*, 227 USPQ 465 (BdPatApp& Int 1985) and in re Lowry, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims

As per claim 15,
Hoffman et al.,('067) discloses the computer network according to claim 14,
wherein said vendor server further comprises a creditor server and a toolbox server and
wherein said toolbox server issues the fingerprint programming for creating a digital fingerprint for use by said creditor server.(Figure 7)

As per claim 21,
Hoffman et al.,('067) discloses a system for verifying the identity of a client computer requesting access to a secured database via a public computer network, said network comprising user's computer, a vendor's server, and further comprising a toolbox server (Figure 1)
The term "for providing third-party verification of user's identity, whereby in response to a request by said vendor's server said toolbox server positively identifies user's computer, requests a confirmation from said user's computer of said request for access and upon receiving said confirmation provides vendor's server with a gatepost for permitting said client computer access to said secured database" is a non-functional descriptive item. The term "for providing third-party verification of user's identity, whereby in response to a request by said vendor's server said toolbox server positively identifies user's computer, requests a confirmation from said user's computer of said request for access and upon receiving said confirmation provides vendor's server with a gatepost for permitting said client computer access to said secured database" could be replaced with other terms. i.e. "a digital ID to identify said user's computer or a hardware identifier ", etc and not change the limitations of the claim. PTO's guidelines for examining claimed language require: the examiner must make a determination, whether the claimed invention "as a whole" would have been obvious at the time of invention to one of ordinary skill in the art. See MPEP 2142. In the pending claim, the examiner submits that particular language does not serve as a limitation on the claim. In other words language that is not functionally interrelated with useful acts, structure, or properties of the claimed invention will not serve as a limitation. See in re Gulak, 217 USPQ 401 (CAFC 1983), *ex parte Carver*, 227 USPQ 465 (BdPatApp& Int 1985) and in re Lowry, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims

As per claim 22,
Hoffman et al.,('067) discloses a system for permitting a secure electronic purchase transaction on a public computer network without passing credit account information over said public computer network, said network comprising;
a user's computer, a vendor's server, a creditor's server, and further comprising a toolbox server .(Figure 1)

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The term "for providing third-party verification of user's identity, whereby in response to a request by said vendor's server said toolbox server positively identifies user's computer, requests a confirmation from said user's computer of said transaction and upon receiving said confirmation provides vendor's server with a gatepass for receiving a payment commitment from said creditor server" is a non-functional descriptive item. The term "for providing third-party verification of user's identity, whereby in response to a request by said vendor's server said toolbox server positively identifies user's computer, requests a confirmation from said user's computer of said request for access and upon receiving said confirmation provides vendor's server with a gatepost for permitting said client computer access to said secured database" could be replaced with other terms. i.e. "a digital ID to identify said user's computer or a hardware identifier", etc and not change the limitations of the claim. PTO's guidelines for examining claimed language require: the examiner must make a determination, whether the claimed invention "as a whole" would have been obvious at the time of invention to one of ordinary skill in the art. See MPEP 2142. In the pending claim, the examiner submits that particular language does not serve as a limitation on the claim. In other words **language that is not functionally interrelated with useful acts, structure, or properties of the claimed invention will not serve as a limitation**. See *in re Gulak*, 217 USPQ 401 (CAFC 1983), *ex parte Carver*, 227 USPQ 465 (BdPatApp& Int 1985) and *in re Lowry*, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims

As per claim 23,

Hoffman et al., ('067) discloses a system for copy-protecting content files downloadable from a computer network,

said network including a user's computer, a vendors server, and a toolbox. (Figure 1)

The term "wherein said users computer has received fingerprint programming from said toolbox for creating a digital fingerprint for use by said toolbox to identify said user's computer, and further comprising said vendor server encoding said digital fingerprint into said content files, whereby said downloaded files will only be downloadable by said user" is a non-functional descriptive item. The term "wherein said users computer has received fingerprint programming from said toolbox for creating a digital fingerprint for use by said toolbox to identify said user's computer, and further comprising said vendor server encoding said digital fingerprint into said content files, whereby said downloaded files will only be downloadable by said user" could be replaced with other terms. i.e. "a digital ID to identify said user's computer or a hardware identifier", etc and not change the limitations of the claim. PTO's guidelines for examining claimed language require: the examiner must make a determination, whether the claimed invention "as a whole" would have been obvious at the time of invention to one of ordinary skill in the art. See MPEP 2142. In the pending claim, the examiner submits that particular language does not serve as a limitation on the claim. In other words **language that is not functionally interrelated with useful acts, structure, or properties of the claimed invention will not serve as a limitation**. See *in re Gulak*, 217 USPQ 401 (CAFC 1983), *ex parte Carver*, 227 USPQ 465 (BdPatApp& Int 1985) and *in re Lowry*, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims

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Allowable Subject Matter

Claims 16-20 and 26-30 are allowable

Claim 24, 25 and 31-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

September 29, 2004

JMW


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
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